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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,626	10/05/2001	Toyoharu Oohata	09792909-5236	4383

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EXAMINER

NGUYEN, DONGHAI D

ART UNIT PAPER NUMBER

3729

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/972,626	OOHATA, TOYOHARU	
	Examiner	Art Unit	
	Donghai D. Nguyen	3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 11-16 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9, 18 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 13, 2004 has been entered.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-9 and 18-19, drawn to a method for mounting a plurality of elements, classified in class 29, subclass 832.

II. Claims 11-17, drawn to a method for separating a plurality of elements, classified in class 29, subclass 426.1.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions Group I and Group II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group II has separate utility such as separating elements on the substrate from the substrate and/or the invention of Group I has separate utility such as mounting elements on the mounting board. See MPEP § 806.05(d).

Art Unit: 3729

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with David Rozenblat on August 27, 2004 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-9, 18, and 19. Affirmation of this election must be made by applicant in replying to this Office action. Claims 11-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

9. Claims 5 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “film-like support” (claim 5, line 14) is vague and indefinite, since it is unclear as to exactly what is being considered as a film-like support.

The phrase “said specific magnification” (claim 8, line 4) lacks antecedent basis.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 2, 4, 7-9, 18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Sadamasa et al.

Regarding claims 1, and 18, Sadamasa et al. a method for mounting a plurality of elements comprising: separating a plurality of elements (100), which are two-dimensionally formed and arrayed at a first period on a substrate (Col. 5, lines 5-8), into individual elements while keeping the first period as it is (Fig. 3), wherein a two-dimensional array of the elements is separated from the substrate (Fig. 3); handling the individual separated elements so as to re-array the elements at a second period having a value equivalent to a multiple of the first period (Figs. 3 and 4); and transferring the re-arrayed elements on a mounting board, wherein the elements are mounted to the mounting board at a period equivalent to the second period (Col. 7, lines 62-65).

Regarding claims 2, 4, 7 and 8, see Figs. 3-4.

Regarding claims 9 and 19, see Col. 7, lines 33-35.

Art Unit: 3729

12. Claims 1-4, 7-9, 18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Zavracky et al.

Regarding claims 1 and 18, Zavracky et al disclose a method for mounting a plurality of elements, comprising: separating a plurality of elements (206/304), which are two-dimensionally formed and arrayed at a first period on a substrate (30/202 and Fig. 11C), into individual elements while keeping the first period as it is (Fig. 13A), wherein a two-dimension arrayed of elements is separated from the substrate; handling the individually separated elements so as to re-array the elements at a second period having a value equivalent to a multiple of the first period (Fig. 13C); and transferring the re-arrayed elements on a mounting board (14/288), wherein the elements are mounted to the mounting board at a period equivalent to the second period (Figs. 12A-12C).

Regarding claim 2, 4, and 8, see col. 14, lines 34-39.

Regarding claim 3, see Col. 14, lines 7-8.

Regarding claim 7 see Fig. 13A-13C.

Regarding claims 9 and 19, see Col. 2, lines 23-25.

Allowable Subject Matter

13. Claim 5 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

14. Claim 6 is allowed.

Art Unit: 3729

Response to Arguments

15. Applicant's arguments with respect to claims 1-4, 7-9 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donghai D. Nguyen whose telephone number is (703) 305-7859. The examiner can normally be reached on Monday-Friday (9:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (703) 308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DN


PETER VO
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